UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,927	01/24/2001	John Russell	OR00-11201	5476

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EXAMINER
BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/769,927	RUSSELL, JOHN
	Examiner	Art Unit	
	James H. Blackwell	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 November 2005</u>.

2a)☒ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15 and 17-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15 and 17-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>24 January 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to amendment received 11/04/2005 with an

original priority date of **01/24/2001**.

2.   Claims 1-21 are pending, Claims 1, 14-15, and 17 are independent.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 11-15 and 17-21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Primis (Primis Custom Publishing, web pages describing product and

features, dated circa 1998, Pages 1-12).

In regard to independent Claim 1 (and similarly independent Claims 14-15

and 17), Primis teaches *a method of composing a virtual book from a set of*

electronically stored documentation comprising multiple books in that it allows a user

(e.g., teacher, instructor, professor) to create custom publications online (*virtual*) using a

custom publishing database that contains a collection of modular, stand-alone text files

that can be mixed and matched and then seamlessly *arranged* to create a book "on

demand" for a particular course (Pgs. 1-12).

Primis also teaches *identifying a plurality of topics based on the chapter and*

section headings in the documentation, wherein each said topic is associated with a

portion of the documentation (see Pgs. 6-12 showing publications listed by title, section (Pg. 6 first and third bullets); Pg. 7 shows details of 1st bullet of Pg. 6 chapter and section headings in document).

Primis also teaches *determining a structure of the documentation, wherein said structure indicates a hierarchy of said topics within the documentation* (see Pg. 9 shows a view of a hierarchy of said topics that the user can choose to view or add to their customized textbook from a given document source Hilton).

Primis also teaches *classifying each of said topics within one or more categories* (Pg. 9 provides the opportunity for the author to reorder the content of the customized textbook, see option for *Resequence* in upper right-hand corner of page).

Primis also teaches *receiving a subject for a virtual book* (Pg. 4).

Primis also teaches *composing said virtual book to include a subset of said topics that are relevant to said subject, and each said relevant topic includes a pointer to said associated portion of the documentation* (Pg. 9 show options to add topics to the customized textbook by clicking Add to specific topics and subtopics within the Hilton text). The user can add or view content by clicking on links associated with topics in the various publications available, Pg. 9 depicting one such example document).

Primis strongly implies that *the complete virtual book can be stored for future access* in that, once a professor or teacher gets the customized textbook into a form ready for publication, a student would have needed options to either buy a printed version at a bookstore, buy it online and download it, or buy a password to view it online. In each of these and other instances, it would have been obvious to one of

ordinary skill in the art at the time of invention that the completed customized textbook

would have been stored, and specifically *stored for future use* as evidenced by offering

it to students for a variety of purchase and viewing options as suggested by Primis.

In regard to dependent Claim 2, Primis teaches *searching said topics for a set*

of topics relevant to said subject (Pg. 7 user can scroll the web page (*search*) the

holdings that are available within the subject previously chosen).

In regard to dependent Claim 3, Primis teaches that *said relevant topics are*

grouped in said virtual book by said categories (see Pg. 9 proposed customized

textbook would show a layout (perhaps default) where topics are grouped by categories;

e.g. Introduction to Law (Chapter 1) (category), topic Business Decision: Calling all

Smokers (topic) and where the designer of the customized textbook would click Add to

add topics perhaps sequentially as listed in the particular reference and by sequence of

references chosen).

In regard to dependent Claim 4, Primis fails to explicitly teach that *said relevant*

topics within a first category are listed in the order of their relevance to said subject.

However, Primis does allow the creator of the customized textbook to restructure the

layout of the final textbook (see Pg. 9, graphic upper right options to review and

resequence the content) and thus would have allowed the creator to structure the topics

by relevance to the subject, or by other desired means capable with such an interface.

Thus, it would have been obvious to one of ordinary skill in the art at the time of

invention to restructure the layout of the customized textbook to order the topics to be

listed by their relevance to the subject providing the reader of the customized textbook a

natural flow of ideas.

In regard to dependent Claim 5, Primis teaches that *said relevant topics within*

a first category are listed in the order they occur within the documentation (refer to the

rejection of Claims 3-4 above, the creator using the interface of Pg. 9 can alter the

topics to be ordered in any way available or desired).

In regard to dependent Claim 6 (and similarly dependent Claim 19) and 7,

Primis fails to explicitly teach *identifying index entries in the documentation* and *said*

index entries are included in said virtual book. However, it would have been obvious to

one of ordinary skill in the art at the time of invention to identify topics for an index and

to incorporate the index into the final customized textbook as these functions were

typically performed with respect to most publications produced, regardless of how they

are produced as a means to allow a user of the customized textbook to locate topics of

interest without having to manually search the entire content of the book for those

topics.

In regard to dependent Claim 8, refer to the rejections of Claims 4 and 5, where

sorting said relevant topics according to their relevance to said topic would have been

taught by Primis along the lines of the arguments presented in those rejections.

In regard to dependent Claim 9 (and similarly dependent Claim 21), Primis

teaches that *said categories include one or more of the set of: concept, task, example,*

reference and troubleshooting (see Pgs. 6-12 for examples of categories relating

concepts, examples, and other category types).

In regard to dependent Claim 10 (and similarly dependent Claim 20), Primis

teaches *identifying a characteristic of a viewer of said virtual book; and customizing said*

virtual book for the viewer on the basis of said characteristic in that a primary intention

of Primis is to offer customized publishing for the purpose of producing course materials

for students taking a particular course (Pgs. 1-3). Typically, courses are limited to a

particular subject matter and topics within that subject matter are taught to students with

a particular interest or need in the course being offered and taught. Thus, it would have

been obvious to one of ordinary skill in the art at the time of invention to realize that an

instructor would have used Primis to design and produce a customized textbook,

keeping in mind the subject matter and interests of the students desiring or needing to

use the course materials.

In regard to dependent Claim 11, Primis teaches that *said characteristic is a*

level of experience since a core feature of the Primis system is to allow an instructor to

design and publish a customized textbook. The content of such a textbook would

necessarily have been catered to the course being taught; whether the course was

introductory or advanced. Thus, the characteristic of *a level of experience* would have

had to be taken under consideration to provide course materials appropriate to the

course level.

In regard to dependent Claim 12, Primis teaches that *said characteristic*

comprises a level of experience of the user and said customizing comprises omitting

one or more of said categories from said virtual book since a core feature of the Primis

system is to allow an instructor to design and publish a customized textbook. The

content of such a textbook would necessarily have been catered to the course being

taught; whether the course was introductory or advanced. Thus, the characteristic of *a*

level of experience would have had to be taken under consideration to provide course

materials appropriate to the course level, and thus excluding content that was not

appropriate for the experience level of the student taking the course.

In regard to dependent Claim 13, refer to the rejections of Claims 11 and 12,

where an *employment role* would imply a certain level of experience whether, for

example, and employee was a new hire or a manager. Using <u>Primis</u>, the instructor of a

course could have created a customized textbook, and in fact, different customized

textbooks based on an *employment role* of a potential student.

In regard to dependent Claim 18, <u>Primis</u> teaches a *network server configured*

to present said virtual book to a user in that the customized textbooks are made

available from a web site (Pgs. 6-12 show screen dumps of the customized content

producing process via a web browser connected to the online Primis Custom Publishing

site).

Response to Arguments

5.   Applicant's arguments with respect to claims 1-21 have been considered but are

moot in view of the new ground(s) of rejection. Applicant argues that the prior arts of

<u>Krulwich, Vaithyanathan</u> and <u>Husick</u> fail to teach the limitations either alone or in

combination. The Examiner respectfully agrees and withdraws the rejection. However,

the Examiner now directs the Applicant to the prior art of <u>Primis</u>, which teaches the

claimed limitations. <u>Primis</u> teaches a web site that allows an instructor to create

customized instruction materials for a class based on a database of titles, or their own

material, or a combination thereof.

Conclusion

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

7.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to James H. Blackwell whose telephone number is 571-

272-4089. The examiner can normally be reached on Mon-Fri.

9.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

10.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
01/17/2006

WILLIAM BASHORE
PRIMARY EXAMINER

1/20/2006